

### **Remarks**

Claims 1-3, 7-25, 27-32, 36-53 and 55-57 are now pending in this application. Claim 6 has been cancelled and claims 7 and 8, which previously depended from claim 6, have been amended to incorporate the subject matter of claim 6. Claim 35 has been cancelled and claims 36 and 37, which previously depended from claim 35, have been amended to incorporate the subject matter of claim 35. Thus, the scope of the amended claims has not been changed. Claim 30 was amended to correct a typographical error.

### **Claim Rejections Under 35 U.S.C. § 101**

The Examiner rejected claims 52, 53, and 55-57 under 35 U.S.C. § 101 because the claimed invention are allegedly directed to a non-statutory subject matter.

Independent claim 52 satisfies the “transforms an item” branch of the test enunciated in *In re Bilski*, 88 USPQ2d 1385 (CAFC) (2008). In particular claim 52 recites “consolidating multiple of the plurality of messages into single message packages.” Thus, a “plurality of messages” are transformed into “single message packages.” For example, an envelope including multiple statements is created instead of multiple envelopes including separate statements. This is clearly a transformation that brings independent claim 52 within patentable subject matter. Accordingly, it is requested that these rejections of claim 52, and its dependent claims be withdrawn.

### **Claim Rejections Under 35 U.S.C. § 112**

The Examiner rejected claim 30 as being indefinite. Claim 30 has been amended to correct the mistake in accordance with the intended understanding as articulated by the Examiner in paragraph 10 of the December 12, 2008 Office Action. Accordingly, this rejection may be withdrawn.

### **Claim Rejections Under 35 U.S.C. § 103**

Applicants hereby incorporate by reference the arguments made in the previous Office Action Response, with the further comments provided below in reply to the Examiner's response.

#### *Rejections Over Schumacher in view of Savage*

The Examiner rejected claims 1-3, 9-17, 30-32, and 38-45 under 35 U.S.C. § 103(a) as being unpatentable over Schumacher in view of U.S. Patent 7,236,950 to Savage, et al. ("Savage").

The Examiner's logic in asserting these two references is defective on its face. It is acknowledged by the Examiner that Schumacher does not disclose the element "wherein the first criteria include marketing business rules determined by the customer relationship management system; and wherein the marketing rules include a rule whether messages that include particular marketing content may be consolidated."

Savage merely teaches that marketing messages can be consolidated, and the Examiner's rejection assumes such disclosure to be sufficient. However, the claim language is directed to "rules" about whether "particular marketing content may be consolidated." Such rules may dictate that certain content may or may not be consolidated. Savage teaches nothing about such rules, and that claim language has been improperly ignored in making these rejections. Because the "rules" components of the claim have not been disclosed or suggested in either reference, no *prima facie* case of obviousness has been made.

#### *Rejections over Schumacher in view of Johnson*

Claims 6-8 and 35-37 were rejected over Schumacher in view of U.S. Publication No. 2004/0230523 to Johnson ("Johnson"). Claims 6 and 35 have been cancelled and the subject matter has been added to their depending claims 7,8, 36, and 37 respectively. Johnson fails to cure the deficiencies identified above with regard to the Schumacher reference in view of the independent claims.

Further, Johnson does not teach using customer preferences to determine whether consolidation (claims 7, 36) or householding (claims 8, 37) is desired in the first place. The Examiner has asserted that Johnson teaches a preference for receiving a hardcopy document. However, this is not what is recited in the claims, so the reference fails to support a *prima facie* case of obviousness. Accordingly, the rejections of these claims should be withdrawn.

*Rejections over Schumacher in view of Stepno*

Claims 18-20, 22, 24-26, 28, 46-48, 50, 52 -54 and 56 were rejected over Schumacher in view of U.S. Publication No. 2002/0133472 to Stepno ("Stepno"). Since Stepno fails to cure the deficiencies of Schumacher with regard to independent claims 1, 24, and 30, the corresponding dependent claims should be allowable for the same reasons.

With regard to independent claim 52, the subject matter of claim 54 has now been added to that independent claim. Neither Schumacher nor Stepno discloses or suggests that "the step of consolidating includes determining whether a customer preference authorizes consolidation for a particular message." The Examiner cites known concern for privacy as the motivation for this component. However, the Examiner has still failed to cite a reference that supports using a "customer preference" to authorize consolidation. While privacy a known problem, the Examiner has provided no support for concluding that such a general concept would result in the particular steps recited.

*Rejections over Schumacher in view of Stepno and Johnson*

Claims 21, 23, 27, 29 49, 51 55 and 57 were rejected over Schumacher in view of Stepno and further in view of Johnson. As cited by the Examiner, Johnson only describes offering discounts for making quick payments. The claims recite describing the benefits of householding or consolidation. Thus, the disclosure of Johnson is different that what is recited in the claims, so it is inadequate to serve as a teaching or disclosure of the element for purposes of making a *prima facie* obviousness rejection. Accordingly, the rejections of these claims should be withdrawn.

*Rejections over Schumacher alone*

Claims 31 - 33 were rejected over Schumacher. As discussed above, Schumacher fails to disclose or suggest the features recited in independent claim 30. Accordingly, these dependent claims should be allowable for the same reasons.

**Conclusion**

All rejections having been addressed, it is submitted that this application is in condition for allowance and favorable action is requested. If there are any questions please contact the undersigned attorney.

Respectfully submitted,

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